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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/701,658	11/30/2000	Carsten Bingel	732/980(26)	5708

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KEIL & WEINKAUF
1350 CONNECTICUT AVENUE, N.W.
WASHINGTON, DC 20036

EXAMINER

LEE, RIP A

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 02/05/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No.	Applicant(s)
	09/701,658	BINGEL, ET AL.
Examiner	Art Unit	
Rip A. Lee	1713	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 07 January 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) The period for reply expires 3 months from the mailing date of the final rejection.
 b) The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
 ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2. The proposed amendment(s) will not be entered because:

- (a) they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) they raise the issue of new matter (see Note below);
- (c) they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. Applicant's reply has overcome the following rejection(s): Winter et al. and/or Winter et al. + Repo et al.

4. Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. The a) affidavit, b) exhibit, or c) request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.

6. The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. For purposes of Appeal, the proposed amendment(s) a) will not be entered or b) will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 9-14.

Claim(s) withdrawn from consideration: _____.

8. The proposed drawing correction filed on _____ is a) approved or b) disapproved by the Examiner.

9. Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). 6.

10. Other: _____


 DAVID W. WU
 SUPERVISORY PATENT EXAMINER
 TECHNOLOGY CENTER 1700

Attachment to Advisory Action

This advisory action follows an after-final response filed on January 7, 2003.

2. The Applicants traverse of the rejection of claims 9-14 under 35 U.S.C. 102(b) as being unpatentable over U.S. Patent No. 5,795,838 to Tsutsui *et al.* The following main points were expressed:

(i) The examiner acknowledges that neither reference discloses compounds wherein R¹ is halogen and R² is an oxygen containing aryloxy group.

While there are no examples provided in the examples section of the patent, such an embodiment is obvious in view of the fact that it is described in the generic claims (col. 58, line 40). Compounds of type Cp₂M(X)(OR), in which Cp is cyclopentadienyl, are also shown in col. 10, lines 48, 49, and 56. Thus, monohalogen complexes are not outside the realm of compounds described in the reference, nor are they beyond the grasp of the skilled artisan.

(ii) The claimed compounds are unexpectedly more soluble than the analogous dihalide compounds.

In regard to the examiner's comment that the result is not too terribly surprising, the Applicants cite *In re Grose*, which indicates that "the Examiner must provide some evidentiary basis for the existence and meaning of the scientific principle relied on." The complete citation indicates that such is required when establishing a *prima facie* case of obviousness. In this case, Tsutsui *et al.* was cited appropriately in establishing the rejection under 35 U.S.C. 103(a).

The examiner maintains the notion that solubility of the compounds shown by the Applicants is not unexpected nor surprising based on the fact that the aryloxy substituent possesses two branched aliphatic groups. Not everything qualifies as a surprising result. If one were to believe the Applicants, the mere fact that compounds of the invention can be made at all would be "surprising" (see specification, page 17, lines 1-3).

(iii) The claimed compounds are at least as polymerization active as their dihalide counterparts and may be more so. The five out of six polymerization runs shown in Repo *et al.* showed the opposite, and thus teaches away from the claimed invention.

The reported activities of 0.53 kg/g catalyst/hr and 0.46 kg/g catalyst/hr are comparable. Repo *et al.* does not teach away from using compounds containing this ligand set. In fact, Table 2 of Repo *et al.* illustrates clearly that higher activity may be achieved using aryloxy monohalide complexes. Thus, one would be motivated to use the compounds described therein. What is unexpected and surprising, then, is the fact that present compounds display comparable activity compared to their dihalide analogues.

3. In view of the discussion above, the rejection of record has not been withdrawn.
4. As such, the proposed amendment of claim 9 will not be entered presently.
5. The rejection of claims 9-14 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,543,373 to Winter *et al.* alone or in combination with Repo *et al.* (*J. Organomet. Chem.* 1977) has been withdrawn.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rip A. Lee whose telephone number is (703)306-0094. The examiner can be reached on Monday through Friday from 9:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached at (703)308-2450. The fax phone number for the organization where this application or proceeding is assigned is (703)746-7064. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

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February 3, 2003